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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,198	04/13/2001	Jon A. Nichols	20-142	5353

7590

12/02/2003

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EXAMINER

QUAN, ELIZABETH S

ART UNIT

PAPER NUMBER

1743

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/835,198

Applicant(s)

NICHOLS ET AL.

Examiner

Elizabeth Quan

Art Unit

1743

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1,3-7,9,13,14,18 and 19.Claim(s) withdrawn from consideration: 20-22.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet

Continuation of 10. Other: Examiner emphasizes that the limitation "actuator being constructed to automatically move said shuttle repeatedly between only the first and second positions" is a method limitation that is accorded no patentable weight in apparatus claims. The language "being constructed" may be interpreted reasonably broad as that the actuator has the capability of being moved between only the first and second positions. The prior art need not explicitly teach the actuator moves between only the first and second positions as long as it is capable of doing so. Applicant has cited passages of the specification to demonstrate that the rotor moves between the first and second positions. However, the key word is "only"--actuator being constructed to automatically move said shuttle repeatedly between "only" the first and second positions. The specification does not provide support for the actuator being constructed to move the shuttle between "only" the first and second positions. The specification discusses examples of the actuator moving between first and second usable positions. There are infinite positions between and outside the two positions. The actuator is capable of moving to other positions, and the specification does not specifically address the actuator being restricted to these two positions. Examiner added Stone as a secondary reference in alternative to each of the primary references Yoshida and Laursen to demonstrate that it is well known to use an automatic actuator. Stone was used only to address the automatic actuator and not the method limitations of moving between only two positions or providing a continuous stream. The limitation of "passing a small portion of a primary stream along a continuous stream" is a method limitation accorded no patentable weight in apparatus claims. The prior art discloses all the structural limitations.

James D. Stone
James D. Stone
10/1/2010